UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Baer	STL000017US1	5170

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EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

NOTIFICATION DATE	DELIVERY MODE
11/25/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 August 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>08/04/2008</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the amendment filed 08/04/2008.

Claims 1-15 are currently pending in this application. Claims 1, 6, and 11 have

been amended. Claims 1, 6, and 11 are independent claims.

35 U.S.C. § 112, 1st paragraph

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and
process of making and using it, in such full, clear, concise, and exact terms as to enable any
person skilled in the art to which it pertains, or with which it is most nearly connected, to make
and use the same and shall set forth the best mode contemplated by the inventor of carrying out
his invention.*

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing

subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of

ordinary skill in art to recognize the features *"automatically adding or removing*

the designated prerequisite content entities to or from the list without further

user intervention beyond initiating the addition or removal of the selected

content entity to add or remove the prerequisite content entities to or from the

content object in addition to the addition or remove of the selected content

entity" (Claims 1, 6, and 11) as amended/added by Applicant in the amendment

filed 08/04/2008.

The Examiner could not locate the details of the features *"automatically adding or*

removing the designated prerequisite content entities to or from the list without

further user intervention beyond initiating the addition or removal of the selected

content entity to add or remove the prerequisite content entities to or from the

content object in addition to the addition or remove of the selected content entity"

in the specification.

Dependent claims 2-5, 7-10, and 12-15 are rejected for fully incorporating the

deficiencies of their base claims.

Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b),by another filed in the United States before the invention by the applicant for patent or (2)a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2)of such treaty in the English language; or " (Emphasis added.)

Claims 1-3, 6-8, and 11-13 remain rejected under 35 U.S.C. 102(e) as being

anticipated by **Mortimer et al.** (US 6091930, filed 03/04/1997).

As to claims 1, 6, and 11:

Mortimer teaches a method, program storage device, and system for providing

prerequisite checking in a system for creating a content object *(generates a*

professor CITbook 40), being one of a book, a document, a collection of

images, a collection of musical selections, a video and a multimedia object, from

a plurality of individual content entities including content for the content object

and stored in a data repository as a plurality of individual file objects, some of

the content entities being prerequisites to others of the content entities and the

content object being defined by a list indicating the content entities from the

data repository specified by a user for the content object *[see the Abstract and*

col. 6, lines 15-22], the method comprising the steps of:

- adding or removing a selected content entity to or from the list to indicating

  the content entities from the data repository specified by the user for the

  content_object to add or remove the selected content entity to or from the

  content object *[See Col. 18, line 61- Col.19, line 28 and Col. 22, lines 37-*

  52: the professor CITbook 40, for a specified group of chapters, links are

  created in a predetermined or preferred sequence linking the material

  together to define a primary route through the chapters similar to a course

  syllabus ... the form of pointers, addresses, indexes, linked lists, trees, or

  any other data ... connect a series of topics or chapters of a selected

  subject in a predetermined primary sequence in order to simulate a

  sequence of an actual text book ... focus on only selected topic which are

  deemed important for a particular class), wherein a prerequisite content

  entity is associated with another content entity and designated for

  inclusion in each content objects for which that other content entity is

  selected and placed [See C*ol. 6, lines 54-67; Col. 7, line 39 - Col. 8, line*

  67;and Col. 15, line 37- Col. 16, line 12: a set of predefined data-entry

  rules 74 or specifications for the document-entry ... specifying a selected

  data format which the data must comply with before it is accepted ...

  provide for formatting, organizing, categorizing and integrating the

inputted material into a professor CITbook ... generating a set of rules and

restrictions with which inputted information must comply ... the rules are

easily complied with allowing the user to focus on entering the content of

the material. With the selected entry rules, all information inputted into the

interactive system will have a standard and uniform format), and wherein

designations prerequisite content entities for content entities within the

data repository are stored external of the individual file objects containing

the content entities *[See Col. 16, lines 25-47: assembles files containing*

audio/video clips, images, illustrations, simulations, embedded or

background text, and the main text which is the controlling component of

the material, the expert contribution manager 210 links, stores, and

formats the new material and incorporates it into the student CITbook 50

... images, videos, and simulations will still be edited and stored

elsewhere, but the expert contribution manage];

- examining the stored associations between content entities and

  prerequisite content entities and determining if the selected content entity

  has any prerequisite content entities designated for that content entity

  [See Col. 7, lines 38-62; Col. 8, lines 39-51; and Col.13, lines 18-32: data

  including text, images, illustrations, simulations, audio and video for

  inclusions ... determine which portions of the collected data are well-

  accepted among experts in the relevant field. The well-accepted data

includes data which is believed to be "true" at the time of review and of

course includes established proven theories and topics. The set of well-

accepted data is considered the "truth" in the relevant field of study and

forms a primary knowledge base of the professor CITbook 40. Preferably,

a separate professor CITbook 40 is generated for each selected scientific

area or subject matter],

and if so, automatically adding or removing the designated prerequisite

content entities to or from the list without further user intervention beyond

initiating the addition or removal of the selected content entity to add or

remove the prerequisite content entities to or from the content object in

addition to the addition or remove of the selected content entity *[See Col.*

21, line 62- Col. 22, line 20; See also, Claim 16: the existence of

embedded links along the predetermined sequence allows a student to

dynamically change the presentation sequence … A student studying an

advanced undergraduate or graduate level course begins the presentation

sequence 430 at the graduate level as shown by point 450. As the

presentation progresses, the student realizes that background information

is needed and selects an embedded link which transports the presentation

to a college undergraduate level 452. The presentation then returns to the

graduate level at 454 until an advance topic link is selected which changes

the presentation to a very knowledgeable level at 456 for a selected time

… the student dynamically changes the predetermined presentation

sequence to accommodate the student's level of comprehension or to

pursue personal interests].

As to claims 2, 7, and 12:

Mortimer teaches one or more of the prerequisites are conditional *[See Col. 15,*

line 52-col. 16, line 12: a set of rules and restrictions with which inputted

information must comply].

As to claims 3, 8, and 13:

Mortimer teaches the conditions for applying a prerequisite are defined in one or

more rules *[See Col.8, lines 18-51: a set of predefined data-entry rules 74 or*

specifications for the document-entry process. The rules include specifying a

selected data format which the data must comply with before it is accepted by the

interactive system. The data-entry rules provide for formatting, organizing,

categorizing and integrating the inputted material into a professor CITbook …

rules 74 also include categorization rules which determine the category of each

portion of entered text such as "Subject Matter," "Topic," "Chapter Title," and

"Education Level." Categorization is performed for example by searching for key

words or requesting the data-entry person to identify the material].

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious at
the time the invention was made to a person having ordinary skill in the art to which said subject
matter pertains. Patentability shall not be negatived by the manner in which the invention was
made.*

*This application currently names joint inventors. In considering patentability of the claims under 35
U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly
owned at the time any inventions covered therein were made absent any evidence to the contrary.
Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of
each claim that was not commonly owned at the time a later invention was made in order for the
examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior
art under 35 U.S.C. 103(a).*

Claims 4-5, 9-10, and 14-15 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over **Mortimer et al.** in view of **Tabuchi** (US 6606633, filed

09/1999).

As to claims 4, 9 and 14:

Tabuchi teaches in the case of more than one of the rules pertaining to the same

prerequisite, further comprising the step of reducing the rule set if possible into a

smaller set of rules [See *Col. 4, lines 4-60;Col. 10, line 59 - Col. 11, line 36 & see*

fig.5 and the associated text].

It would have been obvious to a person of ordinary skill in the art at the time the
invention was made to modify Mortimer with Tabuchi because it would have
provided the capability for checking a possibility/impossibility of relating of a data
object with reference to the structuring rule table, and the compound document
object, when newly relating to other object, inquires of the rule searching means
whether relating of the objects in a desired relation is possible or not.

As to claims 5, 10 and 15:

Tabuchi teaches the step of rewriting any negative rules as positive rules [See
*Col.11, lines 23-37: whether a structuring rule is being used in a compound
document object or can not be recognized ... when the number of references of
the designated structuring rule is not 0, the structuring rule in question will not be
deleted*].

It would have been obvious to a person of ordinary skill in the art at the time the
invention was made to modify Mortimer with Tabuchi because it would have
provided the capability for checking a possibility/impossibility of relating of a data
object with reference to the structuring rule table, and the compound document
object, when newly relating to other object, inquires of the rule searching means
whether relating of the objects in a desired relation is possible or not.

Response to Arguments

5.   Applicant's arguments filed 08/04/2008 have been fully considered but they are

not persuasive.

Applicant argues in substance that Mortimer does not teach automatically adding

or removing the designated prerequisite content entities to or from the list without

further user intervention beyond initiating the addition or removal of the selected

content entity [Remarks, page 10].

The examiner disagrees. Mortimer's teaching *"the existence of embedded links*

along the predetermined sequence allows a student to dynamically change the

presentation sequence ... A student studying an advanced undergraduate or

graduate level course begins the presentation sequence 430 at the graduate

level as shown by point 450. As the presentation progresses, the student realizes

that background information is needed and selects an embedded link which

transports the presentation to a college undergraduate level 452. The

presentation then returns to the graduate level at 454 until an advance topic link

is selected which changes the presentation to a very knowledgeable level at 456

for a selected ... the student dynamically changes the predetermined

presentation sequence to accommodate the student's level of comprehension or

to pursue personal interests" [See Col. 21, line 62 - Col. 22, line 20] covers the

claimed *"automatically adding or removing the designated prerequisite content entities to or from the list without further user intervention beyond initiating the addition or removal of the selected content entity."*

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact information

7.   Any inquiry concerning this communication or earlier communications from the examiner
should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093.
The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If
attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is
assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published
applications may be obtained from either Private PAIR or Public PAIR. Status
information for unpublished applications is available through Private PAIR only. For more
information about the PAIR system, see http://pair-direct.uspto.gov. Should you have
questions on access to the Private PAIR system, contact the Electronic Business Center
(EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer
Service Representative or access to the automated information system, call 800-786-
9199 (IN USA OR CANADA) or 571-272-1000.

/Maikhanh Nguyen/
Examiner, Art Unit 2176

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